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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,976	05/22/2001	David Pacifici	A32137A	1995

7590 04/07/2003

BAKER BOTTS LLP
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NEW YORK, NY 10112-4498

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 04/07/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,976

Applicant(s)

PACIFICI, DAVID

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on January 22, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/862,976 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg et al. (4,447,481) in view of Hanson et al. (4,673,324).

Holmberg et al. disclose a method of irreversibly binding a plurality of sheets together comprising superimposing a sheet (10) having an adhesive strip comprising an adhesive element (14 –adhesive/glue) and a protective strip (16) releasably placed on the glue and having at least a portion (16b) not coupled to the glue (as seen in figure 4), such that the uncoupled portion may be used to grasp the protective strip during its removal over a second sheet (see col. 2, lines 52-58); grasping the uncoupled portion of the strip and pulling the uncoupled portion of the strip so as to uncover the glue and thereby irreversibly bind the two sheets together (see col. 2, lines 52-62).

Holmberg et al. disclose the claimed invention except for explicitly disclosing the strip being made of a silicone material. Silicone release liners are widely used for

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providing a protective covering over adhesives/glues. Hanson et al. disclose a method and sheet for binding pages comprising a sheet (30) having an edge (32) and a coating of pressure sensitive adhesive (34). A coating (35) of low adhesion (silicone) material is coated on the sheet adjacent the adhesive to provide a protective covering for the adhesive until the sheet is to be used. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holmberg's invention by providing the protective strip being made of a silicone material, as taught by Hanson et al., to provide a protective covering that is comprised of low adhesion material enabling easy removal of the protective covering from the glue.

Regarding claim 19, see the above rejections.

Regarding claim 20, Holmberg et al., as modified by Hanson et al., disclose the claimed invention except for the plurality of sheets being bound to at least one sheet not having an adhesive strip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bind the sheets having adhesive strips to sheets not having adhesive strips, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184. Even though the sheet to be bound with the remaining sheets which have adhesive strips does not, itself, include an adhesive strip, the sheet would continue to be able to be bound to the assembly as the non-adhesive sheet would adhere to the adhesive strip on the sheets comprising adhesive strips.

Regarding claim 21, Holmberg et al., as modified by Hanson et al., disclose the claimed invention except for sheet being capable of being used in a loose-leaf ring binder providing a binding cover.

Response to Arguments

4. Applicant's arguments with respect to claims 7 and 19-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited reference discloses a sheet prepared for binding, and adhesive band for binding loose sheets.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



**MONICA CARTER
PATENT EXAMINER**

April 2, 2003